

## REMARKS

### **I. Introduction**

Claims 11 and 14-20 are pending in the present application. For at least the reasons set forth below, Applicants respectfully submit that the claims are in condition for allowance.

### **II. Rejection of Claims 11 and 14-20 under 35 U.S.C. § 112, First Paragraph**

Claims 11 and 14-20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner noted that the following claimed features are new matter: “the controller continuously checks the sensor device during the stop-and-go operation for at least one predefined condition, wherein the at least one predefined condition includes a turning operation of the motor vehicle, and wherein the turning operation is detected when a turn radius is smaller than a predefined threshold value, the turn radius being determined by an evaluation of one of a yaw rate signal and a steering angle signal.” In response, Applicants note that the claimed features are clearly described in the specification and in the drawings, as explained in detail below.

With respect to the claimed features discussed by the Examiner, p. 3, l. 3-13 of the original specification clearly indicate the following: “according to . . . the present invention, one of the **conditions which trigger the shutdown of the stop-and-go function is the detection of a turn**”; “[o]ne criterion for **detecting a turn** may be the fact, for example, that the **radius of a turn negotiated by the vehicle is smaller than a predefined value**”; “the vehicle's yaw rate may be measured using a yaw rate sensor, or the transverse acceleration may be measured using an acceleration sensor, and **the turn radius may then be calculated from the measured vehicle speed and the yaw rate or the transverse acceleration**”; and “[t]he **steering angle** may optionally or additionally also be evaluated.” In addition, the original specification clearly indicates that “Figure 3 shows a flow chart of a **program which is constantly run** in the background by controller 12 **as long as the stop-and-go function is active**,” (p. 6, l. 18-19), and the steps shown in Figure 3 are explained as follows:

The turn radius  $R$  of the turn negotiated by the vehicle at this very moment is calculated in step S3 based on the vehicle speed and the measured transverse acceleration of the vehicle, for example, and compared with a threshold value  $R_{MAX}$ . If  $R$  is greater than  $R_{MAX}$ , it means that the vehicle travels essentially straight ahead, i.e., no turning. (P. 6, l. 28-31).

If step S3 shows that the instantaneous **turn radius R** is smaller than  $R_{MAX}$ , the program branches to step S5. A timer T is started in step S5 and a flag is set to "1" to indicate that the timer is running. If the timer was already started in a previous cycle, which is indicated by a flag value different from zero, then there is no action taken in step S5. (P. 7, l. 9-12).

It is then checked in step S6 whether the value of timer T is greater than a predefined waiting time  $T_1$ . If this is not the case, the program jumps back to step S3. (P. 7, l. 14-15).

If, during a time interval of length  $T_1$ , **turn radius R** remained constantly smaller than  $R_{MAX}$ , then the conclusion was drawn that **a turn was in progress**. In this case, the driver is requested in step S7 to take over vehicle control himself. In addition, the flag is reset to zero. (P. 7, l. 17-19).

As can be seen from the above, the original specification unequivocally described the claimed features that "the controller continuously checks the sensor device during the stop-and-go operation for at least one predefined condition, wherein the at least one predefined condition includes a turning operation of the motor vehicle, and wherein the turning operation is detected when a turn radius is smaller than a predefined threshold value, the turn radius being determined by an evaluation of one of a yaw rate signal and a steering angle signal." Accordingly, for at least the foregoing reasons, Applicants submit that claim 11 and its pending dependent claims 14-20 are in compliance with the written description requirement under 35 U.S.C. § 112, first paragraph.

Claims 11 and 14-20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner noted that it is not clear what "the at least one predefined condition" recited in claim 11 is. In response, Applicants note that claim 11 clearly indicates that "**wherein the at least one predefined condition includes a turning operation of the motor vehicle,**" which claimed feature is clearly described in the original specification, as explained above.

For at least the foregoing reasons, Applicants submit that claim 11 and its pending dependent claims 14-20 are in compliance with the enablement requirement under 35 U.S.C. § 112, first paragraph.

### III. Rejection of Claims 11 and 14-20 under 35 U.S.C. § 102(e)

Claims 11 and 14-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,560,525 ("Joyce"). Applicants respectfully submit that Joyce fails to anticipate claims 11 and 14-20, for the reasons explained below.

To anticipate a claim under 35 U.S.C. §102(e), a single prior art reference must identically disclose each and every claim feature. See Lindeman Machinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Amended claim 11 recites, in relevant parts, "a sensor device for measuring an operating parameter of the motor vehicle and for measuring a distance to an object located in front of the motor vehicle"; "a controller for controlling one of a speed and an acceleration of the motor vehicle as a function of the measured operating parameter and the measured distance [[data]] to the object"; "the controller includes a stop-and-go function . . . , and the controller continuously checks the sensor device during the stop-and-go operation for at least one predefined condition, wherein the at least one predefined condition includes a turning operation of the motor vehicle, and wherein the turning operation is detected when a turn radius is smaller than a predefined threshold value, the turn radius being determined by an evaluation of one of a yaw rate signal and a steering angle signal, and in the presence of the at least one predefined condition, initiates a procedure for the shutdown of the stop-and-go function." It should be noted that the "turning operation of the motor vehicle" recited in claim 11 is the turning operation of the host vehicle that is controlled by the claimed "controller."

In support of the rejection, the Examiner summarily concludes on pages 4-5 of the Office Action, without any cited support, that Joyce teaches the following claimed features: "the controller continuously checks the sensor device during the stop-and-go operation for at least one predefined condition, wherein the at least one predefined condition includes a turning operation of the motor vehicle, and wherein the turning operation is detected when a turn radius is smaller than a predefined threshold value, the turn radius being determined by an evaluation of one of a

yaw rate signal and a steering angle signal, and in the presence of the at least one predefined condition, initiates a procedure for the shutdown of the stop-and-go function.” In this regard, the Examiner implicitly contends that the limitations describing the “controller” may be ignored because these limitations are “method limitation or statement of intended or desired use, [which] do not serve to patentably distinguish the claimed structure over that of the reference.” (Office Action, p. 6). Furthermore, the Examiner also contends that “it is believed that the prior art is **capable of performing** the recited limitations.” (Office Action, p. 7). Applicants will address these contentions in detail below.

Initially, Applicants note in determining whether a patent claim is invalid as being anticipated by prior art, functional language such as “adapted to” or “for performing” cannot be disregarded. See Pac-Tec, Inc. v. Amerace Corp., 903 F.2d 796, 801 (Fed. Cir. 1990), cert. denied, 502 U.S. 808 (1991). This rule has been consistently upheld by the C.C.P.A. and its successor court, the C.A.F.C., since the seminal case of In re Swinehart, 439 F.2d 210, 212 (C.C.P.A. 1971), which unequivocally indicated that regarding “[t]he fact that an attempt is being made to define something . . . by what it does rather than what it is . . . , there is nothing intrinsically wrong with the use of such a technique in drafting patent claims.” As an example of more recent C.A.F.C. decision, In re Schreiber, 128 F.3d 1473, 1478, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997), clearly indicates that “a patent applicant is free to recite features of an apparatus either structurally or functionally.” Applicants further note that this rule is explicitly stated in the M.P.E.P, e.g., M.P.E.P. 2173.05(g). Accordingly, Applicants note that the functional limitations recited in the present claims must be taught by the prior art in order to establish anticipation.

In support of the rejection, the Examiner cites col. 3, lines 15 ff., as teaching the claimed features of independent claim 11. However, Applicants note that nothing in Joyce, including the cited section, actually teaches the claimed features. For example, in col. 3 of Joyce, there is mention of only “various indicators 28” (col. 3, line 34), but this does not relate to suggestions for a turning maneuver. The phrase “various indicators” is elucidated in greater detail in col. 5, l. 11-20 of Joyce, and this phrase merely refers to driver warnings which inform the driver about situations such as the standstill of the controlled vehicle and the driving-off of the preceding target object. Although Joyce discusses in column 5, lines 34-56 (in connection with Figs. 4 and 5) situations in which a controlled vehicle 12 outfitted with the ACC system 10 is following a preceding vehicle (66, 70) traveling in front the controlled vehicle 12, and the preceding vehicle (66, 70) performs a turning maneuver, there is absolutely no suggestion in

Joyce that the controlled vehicle 12, i.e., the following vehicle, is equipped with a “controller [that] continuously checks the sensor device during the stop-and-go operation” for a turning operation of the controlled vehicle. In addition, there is absolutely no suggestion in Joyce that “the turning operation is detected when a turn radius is smaller than a predefined threshold value, the turn radius being determined by an evaluation of one of a yaw rate signal and a steering angle signal.” Furthermore, there is no suggestion in Joyce that, upon detection of the turning operation of the controlled vehicle, a procedure for the shutdown of the stop-and-go function is initiated. Joyce merely indicates that, if the preceding vehicle is turning, the following controlled vehicle is held to a standstill, or alternatively, follows behind the preceding vehicle that is turning off.

Independent of the above, to the extent the Examiner contends that “it is believed that the prior art is **capable of performing** the recited limitations,” Applicants note that simply being “capable of performing” is insufficient to establish an anticipation rejection: in order to anticipate a claim, a single prior art reference must identically disclose each and every claim feature, which is clearly lacking in the present rejection. To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic. Accordingly, even if one assumes for the sake of argument that Joyce may indeed be “capable of performing the recited limitations” (which is clearly not the case, since there is no suggestion in Joyce for such conclusion), the teachings of Joyce still would not be sufficient to support a rejection since there is no reasonable basis to conclude that the present claimed features would necessarily flow from the teachings of Joyce.

For the foregoing reasons, Applicants respectfully submit that claim 11 and its dependent claims 14-20 are not anticipated by Joyce. Withdrawal of the anticipation rejection of claims 11 and 14-20 is respectfully requested.

**CONCLUSION**

In view of the foregoing, it is submitted that claims 11 and 14-20 are in allowable condition. It is therefore respectfully requested that the present application issue as early as possible.

Respectfully submitted,

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